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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,048	04/04/2006	Kimberly D. Gwinn	UTR.106XC1	6089

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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06/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

euspto@slspatents.com

Office Action Summary	Application No. 10/541,048	Applicant(s) GWINN ET AL.	
	Examiner ALTON N. PRYOR	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-29 and 43-66 is/are pending in the application.
- 4a) Of the above claim(s) 24-27, 29, 43-47, 50-53, 55-60, 63, 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 23, 28, 48, 49, 54, 61, 62, 64 and 66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments filed 3/15/10 have been fully considered but they are not persuasive. See argument below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22,23,48,49,62 are rejected under 35 U.S.C. 102(b) as being anticipated by Gould et al. (USPN 4676985; 6/30/87). Gould et al. teach a method of protecting corps from damage by soil-inhabiting insect pests comprising coating plant seeds with a bergamot plant extract followed by the planting of the seed (abstract, column 3 lines 9-30) or by coating below-ground portions of the seedlings with plant extract such as bergamot (abstract). Gould et al. teach that the coated seedlings are then transplanted into the field by conventional techniques. Note, bergamot is a Monarda species. Gould et al. do not teach explicitly the application of the extract to the soil. However, Gould et al. make it inherent that the extract would eventually contact the soil because Gould et al. teach that the seed or below-ground portion of the seedling coated with a bergamot extract is planted in the field.

Response to Applicants' Argument

Applicants argue that Gould et al. do not teach a method of controlling weeds or fungal pathogens. Applicants argue that Gould et al. do not teach expressly or by

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inherency the application of *Monarda* spp. (bergamot) composition to soil as claimed. In fact, Gould et al. explicitly teach that the liquid bergamot extract is coated on the seed. The Applicants argue that there is no utility to apply the bergamot extract, which is taught by Gould et al. as a feeding deterrent against soil-inhabiting corn wireworms, to the sites recited in the claims. Applicants argue that Gould et al. fail to anticipate the claimed invention as it the use of fresh or dried bioactive herbage. The Examiner argues that Gould et al. at column 3 lines 9-30 teach that bergamot is applied to underground portions of plants. The underground portions of plants are in contact with the soil. Therefore, it is inherent that the bergamot would come in contact with the soil once applied to the underground portions of the plants. The claims rejected under 102b do not require the bergamot or *Monarda* spp. to be in dry form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22,23,28,48,49,54,61,64,66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould et al. (USPN 4676985; 6/30/87). Gould et al. teach a method of protecting crops from damage by soil-inhabiting insect pests comprising coating plant seeds with a plant extract followed by the planting of the seed (abstract, column 3 lines 9-30) or by coating below-ground portions of the seedlings with plant extract such as bergamot (abstract). Gould et al. teach that the coated seedlings are then transplanted

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into the field by conventional techniques. Note, bergamot is a *Monarda* species. Gould et al. do not teach explicitly the application of the extract to the soil. However, Gould et al. make it obvious that the extract would eventually contact the soil since Gould et al. teach that the seed or below-ground portion of the seedling coated with a bergamot extract is planted in the field. Gould et al. do not teach that the *Monarda* species is employed in dry form. The instant specification does not provide unexpected data for the dry form versus the liquid or extract form. In the absence of unexpected data for the dried form, Gould et al.'s extract or liquid form makes obvious the dried form claimed. Note, both physical forms contain the same active ingredient and therefore both forms should yield the same or similar result when employed in the same method.

Note, this is true of many pharmaceutical compositions consumed by humans, i.e. the active is provided in a variety of physical forms (e.g. solid and liquid), but all physical forms provide the same effect.

Response to Applicants' Argument

Applicants argue that Gould et al. do not teach the application of the dry form of *Monarda* as claimed. Applicants argue that the Examiner makes a conclusion statement of obviousness, i.e., in the absence of unexpected results for the dry form of *Monarda* as claimed, Gould et al.'s liquid form makes obvious the dry form recited in the claims. Applicants argue that there exist no evidence of record that establishes that the liquid extract form of Gould et al. would be expected to contain the same active ingredient as the dry/solid *Monarda* applied to the soil. The Examiner maintains that Gould et al.'s liquid extract of *Monarda* makes the instant dry/solid form of *Monarda* obvious. Note,

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Gould et al. teach that bergamot extract is *Monarda*. Gould et al. do not teach additional ingredients in the bergamot extract. It is reiterated that many pharmaceutical compositions consumed by humans are provided in a variety of physical forms (e.g. solid and liquid), in which all physical forms yield the same effect or benefit. Optimization of particle size would be determined through routine experimentation.

Election Status

The elected invention comprising the application of a *Monarda* species to soil to control pests is not allowable. See rejections above. Note, claims 27,29,53 and 55 were inadvertently considered in the previous office action. However, claims 27,29,53 and 55 include more than the election and should have been withdrawn. In this office action this correction has been made.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616